

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Eugene J. ROLLINS *et al.*
SERIAL NO.: 09/747,651
ATTORNEY DOCKET NO: 031792-0311567
FILING DATE: December 22, 2000
ART UNIT : 3625
EXAMINER Yogesh C. Garg
FOR: PRE-FILLING ORDER FORMS FOR TRANSACTIONS OVER A COMMUNICATIONS NETWORK

RESUBMISSION OF INFORMATION DISCLOSURE STATEMENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

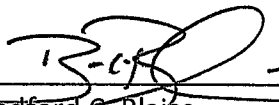
Dear Sir:

Two Information Disclosure Statements ("IDSs") were filed electronically by Applicants on December 14, 2007. To date, however, Applicants have yet to receive copies of the Form PTO-1449s signed by the Examiner (for these submissions) indicating that the cited references were considered. Accordingly, Applicants have provided herewith copies of the IDSs submitted December 14, 2007 together with a PTO Electronic Acknowledgement Receipt. It is respectfully requested the Examiner return initialed and signed copies of the Form PTO-1449s for these submissions.

Date: February 26, 2008

Respectfully submitted,

By:



Bradford C. Blaise
Registration No. 47,429

Customer No. 00909

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 10500
McLean, Virginia 22102
Direct Dial: 703-770-7741
Main: 703-770-7900
Fax: 703-770-7901

Electronic Acknowledgement Receipt

| | |
|---|--|
| EFS ID: | 2594394 |
| Application Number: | 09747651 |
| International Application Number: | |
| Confirmation Number: | 9835 |
| Title of Invention: | PRE-FILLING ORDER FORMS FOR TRANSACTIONS OVER A COMMUNICATIONS NETWORK |
| First Named Inventor/Applicant Name: | Eugene J. Rollins |
| Customer Number: | 909 |
| Filer: | Bradford C. Blaise/Susan Trader |
| Filer Authorized By: | Bradford C. Blaise |
| Attorney Docket Number: | 031792-0311567 |
| Receipt Date: | 14-DEC-2007 |
| Filing Date: | 22-DEC-2000 |
| Time Stamp: | 16:35:05 |
| Application Type: | Utility under 35 USC 111(a) |

Payment information:

| | |
|--|-----------------|
| Submitted with Payment | yes |
| Payment Type | Deposit Account |
| Payment was successfully received in RAM | \$ 180 |
| RAM confirmation Number | 1617 |
| Deposit Account | 033975 |
| Authorized User | |

File Listing:

| Document Number | Document Description | File Name | File Size(Bytes) /Message Digest | Multi Part /.zip | Pages (if appl.) |
|-----------------|----------------------|-----------|----------------------------------|------------------|------------------|
|-----------------|----------------------|-----------|----------------------------------|------------------|------------------|

| | | | | | |
|--------------|---|-------------------|---|-----|----|
| 1 | | 0311567_SIDS.pdf | 356351 522f46a8b88937535ce451740bba3845f6348e42 | yes | 9 |
| | Multipart Description/PDF files in .zip description | | | | |
| | Document Description | | Start | End | |
| | Information Disclosure Statement Letter | | 1 | 8 | |
| | Information Disclosure Statement (IDS) Filed | | 9 | 9 | |
| Warnings: | | | | | |
| Information: | | | | | |
| 2 | NPL Documents | WARD.pdf | 184120 0b62a258cc2e0975ce5781985b37fdeb4966c6b4 | no | 3 |
| Warnings: | | | | | |
| Information: | | | | | |
| 3 | NPL Documents | SMITH.pdf | 185381 f742c42f558b71a621bed5da3c5363ceb324e2b9 | no | 4 |
| Warnings: | | | | | |
| Information: | | | | | |
| 4 | | 0311567_SSIDS.pdf | 106658 5defe7530842038c04caff2935bcb4db57417832 | yes | 4 |
| | Multipart Description/PDF files in .zip description | | | | |
| | Document Description | | Start | End | |
| | Information Disclosure Statement Letter | | 1 | 3 | |
| | Information Disclosure Statement (IDS) Filed | | 4 | 4 | |
| Warnings: | | | | | |
| Information: | | | | | |
| 5 | Foreign Reference | EP0847179.pdf | 1029062 cb1d6ff92ea20371a06b0c1b4818ab5b612c1a94 | no | 18 |
| Warnings: | | | | | |
| Information: | | | | | |
| 6 | NPL Documents | BUSH.pdf | 1209907 6a26ff67b9943ab47eb0a5819910b118b699c7de | no | 14 |
| Warnings: | | | | | |
| Information: | | | | | |

| | | | | | |
|---|------------------------|--------------|--|----|---|
| 7 | NPL Documents | DOHERTY.pdf | 327487 2102e1b3ac1b17e59e16f9c7cc2d45f3f58e2776 | no | 5 |
| Warnings: | | | | | |
| Information: | | | | | |
| 8 | Fee Worksheet (PTO-06) | fee-info.pdf | 8215 4d2584e35ea5439ec67147f928287bd1dfe93e3d | no | 2 |
| Warnings: | | | | | |
| Information: | | | | | |
| Total Files Size (in bytes): | | | 3407181 | | |
| <p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p> | | | | | |

Electronic Patent Application Fee Transmittal

| | | | | |
|---|--|-----------------|---------------|-----------------------------|
| Application Number: | 09747651 | | | |
| Filing Date: | 22-Dec-2000 | | | |
| Title of Invention: | PRE-FILLING ORDER FORMS FOR TRANSACTIONS OVER A COMMUNICATIONS NETWORK | | | |
| First Named Inventor/Applicant Name: | Eugene J. Rollins | | | |
| Filer: | Bradford C. Blaise/Susan Trader | | | |
| Attorney Docket Number: | 031792-0311567 | | | |
| Filed as Large Entity | | | | |
| Utility Filing Fees | | | | |
| Description | Fee Code | Quantity | Amount | Sub-Total in USD(\$) |
| Basic Filing: | | | | |
| Pages: | | | | |
| Claims: | | | | |
| Miscellaneous-Filing: | | | | |
| Petition: | | | | |
| Patent-Appeals-and-Interference: | | | | |
| Post-Allowance-and-Post-Issuance: | | | | |
| Extension-of-Time: | | | | |

| Description | Fee Code | Quantity | Amount | Sub-Total in USD(\$) |
|---|----------|----------|--------|----------------------|
| Miscellaneous: | | | | |
| Submission- Information Disclosure Stmt | 1806 | 1 | 180 | 180 |
| Total in USD (\$) | | | | 180 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Eugene J. ROLLINS *et al.* CONFIRMATION No.: 9835
SERIAL NUMBER : 09/747,651 EXAMINER: Yogesh C. Garg
FILING DATE : December 22, 2000 ART UNIT: 3625
FOR : PRE-FILING ORDER FORMS FOR TRANSACTIONS OVER A COMMUNICATIONS NETWORK

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the duty of disclosure under 37 C.F.R. §§ 1.56, 1.97 and 1.98, Applicants hereby make of record in the above-identified application the documents listed on the attached Form PTO-1449.

Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This Supplemental Information Disclosure Statement is being filed more than three months after the filing date of a national application other than a continued prosecution application under 37 C.F.R. §1.53(d), or more than three months after the date of entry of the national stage as set forth in 37 C.F.R. §1.491 in an international application, and after the mailing date of any of a Final Action under 37 C.F.R. §1.113, a Notice of Allowance under 37 C.F.R. §1.311, or an action that otherwise closes prosecution in the application, but on or before payment of the Issue Fee. 37 C.F.R. §1.97(d).

I hereby certify that each item of information contained in this Supplemental Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Supplemental Information Disclosure Statement. 37 C.F.R. §1.97(e)(1).

Please charge the \$180.00 fee [37 C.F.R. §1.17(p)] to Deposit Account No. 03-3975. In addition, please charge any fee deficiencies, or credit any overpayment, to Deposit Account No. 03-3975 as needed to ensure consideration of the Supplemental Information Disclosure Statement.


These documents were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language version of the search report that indicates the degree of relevance found by the foreign office is provided.

It is respectfully requested that the Examiner initial and return a copy of the enclosed
PTO-1449.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

Customer No.
00909

By 
Bradford C. Blaise
Registration No.: 47,429

P. O. Box 10500
McLean, Virginia 22102
Telephone: (703) 770-7900
Telefax: (703) 770-7901

Dated: December 14, 2007

DATE CONSIDERED

400688574v1



✉ EPA/EPO/OEB
D-80298 München
☎ +49 89 2399-0
TX 523 656 apmu d
FAX +49 89 2399-4465

Europäisches
Patentamt

European
Patent Office

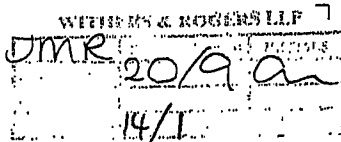
Office européen
des brevets

Generaldirektion 2

Directorate General 2

Direction Générale 2

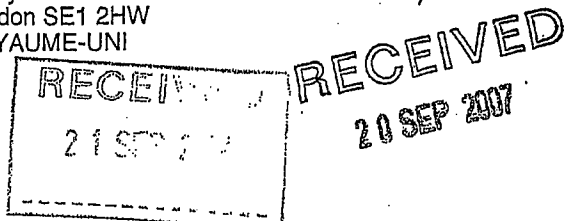
Ribeiro, James Michael
Withers & Rogers
Goldings House
2 Hays Lane
London SE1 2HW
ROYAUME-UNI



Telephone numbers:

Primary Examiner +49 89 2399-7943
(substantive examination)

Formalities Officer / Assistant +49 89 2399-7891
(Formalities and other matters)



| | | |
|--|-----------------------|--------------------|
| Application No. 01 988 333.9 - 2221 | Ref. P104825EP/JMR | Date 14.09.2007 |
| Applicant E-Centives, Inc. | | |

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



Aguilar, José María
Primary Examiner
for the Examining Division

Enclosure(s): 4 page/s reasons (Form 2906)

Datum
Date 14.09.2007Blatt
Sheet 1
FeuilleAnmelde-Nr.:
Application No.: 01 988 333.9
Demande n°:

The examination is being carried out on the following application documents:

Description, Pages

1-5, 8-37 as originally filed
6, 7, 7a received on 26.06.2006 with letter of 21.06.2006

Claims, Numbers

1-14 received on 26.06.2006 with letter of 21.06.2006

Drawings, Sheets

1/12-12/12 as originally filed

Relevant prior art

1. The following documents cited in the search report may be referred to in this communication; the numbering will be adhered to in the rest of the procedure:

D1: US-A-5 712 979 (WEINBERGER MARVIN I ET AL) 27 January 1998 (1998-01-27)

D2: US-A-5 764 910 (SHACHAR YUVAL) 9 June 1998 (1998-06-09)

D3: BARRETT R ET AL: "Intermediaries: new places for producing and manipulating Web content" COMPUTER NETWORKS AND ISDN SYSTEMS, NORTH HOLLAND PUBLISHING, AMSTERDAM, NL, vol. 30, no. 1-7, 1 April 1998 (1998-04-01), pages 509-518, XP004121397 ISSN: 0169-7552

D4: US-A-6 006 197 (D EON CHRISTOPHER E ET AL) 21 December 1999 (1999-12-21)

D5: US-A-5 991 740 (MESSER STEPHEN DALE) 23 November 1999 (1999-11-23)

The following documents are cited by the examiner (see the Guidelines, C-VI, 8.7). Copies of the documents are annexed to the communication and the numbering will be adhered to in the rest of the procedure:

D6: "Pixel-high privacy spy", BBC News Online: Sci/Tech, 20.07.00,
<http://news.bbc.co.uk/2/low/science/nature/842624.stm>

D7: "The Web Bug FAQ", by Richard M. Smith, 11.11.99,
http://www.eff.org/Privacy/Marketing/web_bug.html

**Article 84 EPC**

2. The application does not meet the requirements of Article 84 EPC, because claim 1 is not clear.
 - 2.1 In particular it is not clear from the claim what are the technical features of an "intermediary". Due to the ambiguity in the formulation the claimed intermediary can be interpreted either as a user or as a computer.
 - 2.2 Furthermore, the expression "one or more communications associated with an intermediary" leaves open if the intermediary takes an active role in the communication (e.g. sender, receiver, forwarder) or on the other hand is merely referred to in the communication.
 - 2.3 Similarly, the expression "a location associated with the intermediary" is vague and unclear, since in a network any location can be accessed by any other computer or user.

Articles 54 and 56 EPC

3. Although the description generally relates to tracking the origin of Internet transactions, the subject-matter of claim 1, as far as it can be presently understood (cf. §2), has such a broad scope that is anticipated (Art. 54 EPC) by a well-known method for determining the originator of a communication (telephone, instant messaging, email, etc) in which the stored first communication data consists of a listing of network addresses with the corresponding user names and the second communication is an incoming communication. It is a generally known procedure to compare the network address of the incoming communication with network addresses stored in a listing to determine if a communication is associated with a user.
4. Without prejudice to the foregoing objection under Art. 54 EPC which does not rely on a specific prior art citation as documentary evidence, it is further noted that the cited documents D1, D4 and D5 are considered to provide a basis for further objections to the claimed subject matter under Art. 54 EPC.
 - 4.1 In particular, D1 discloses:



A method for determining whether network communications are associated with an intermediary ("a co-marketer"), the method comprising the computer-implemented steps of :

causing first communication data for one or more communications associated with the intermediary to be stored at a location associated with the intermediary (see look-up table 300 in Fig. 3);

receiving second communication data associated with a particular communication (a destination URL is passed to a web server when a user is directed from a co-marketer site, see col. 7, l. 49-56);

and comparing the first communication data ("look up table") to the second communication data (URL) to determine whether the particular communication is associated with the intermediary ("co-marketer").

D1 therefore discloses all the features of claim 1.

- 4.2 D4 and D5, each document on its own, also anticipate (Art. 54 EPC) the subject-matter of claim 1. In particular D4 discloses (see abstract) the comparison ("correlation") of first communication data (i.e. Impressions recorded when a user clicks on a banner) with second communication data ("post-impression transactional activity").
- 4.3 In addition D5 discloses (see Fig. 5) a clearinghouse server which stores first communication data (site (ID), banner (ID) and user (X), cf. col. 8, l. 57-61), and receives second communication data associated with a particular communication ("information relating to the purchase and the user", cf. col. 9, l. 5-11), which is implicitly compared with the initially stored information in order to calculate a commission to be paid.
5. Dependent claims 2-7 do not appear to contain any additional features which, in combination with the features of any claim to which they refer, meet the requirements of the EPC with respect to novelty and/or inventive step, the reasons being as follows:
- 5.1 The subject matter of claims 2-3 does not appear to justify the presence of an inventive step, as tracer images and cookies are well known means to monitor user activity on the Internet, also in combination (see for example D6, page 2, paragraph 9: *"the (web) bugs work best in conjunction with cookies"*, or D7, question 6 of the Web Bug FAQ).
- 5.2 Regarding claim 4, cookies are known to expire after a specific time period (see for example, D5, Fig. 6, 825).

Datum
Date 14.09.2007
DateBlatt
Sheet 4
FeuilleAnmelde-Nr.:
Application No.: 01 988 333.9
Demande n°:

- 5.3 The subject-matter of claims 5-7 relates to details related to a particular commercial application of the method which appears to be arbitrary from a technical point of view.
6. The above objections to method claims 1-7 are applicable, *mutatis mutandis*, to the corresponding computer readable medium claims 8-14.

Concluding observations

7. The examining division is of the opinion that some of the deficiencies noted above are so severe that there appears to be no possibility of overcoming them by amendment. Unless the applicant is able to provide credible evidence or arguments to the contrary, a refusal of the application is to be expected.
8. Should the applicant nevertheless regard some particular matter as patentable, an independent claim should be filed taking account of Rule 29(1) EPC, indicating in the letter of reply the difference of the subject-matter of the new claim vis-à-vis the state of the art (rather than the other way round) and the **technical effect** provided by the differentiating feature(s).
9. The features of the claims should be provided with reference signs placed in parentheses to increase the intelligibility of the claims (Rule 29(7) EPC).
10. To meet the requirements of Rule 27(1)(b) EPC, documents D1, D4 and D5 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.
11. When filing amended claims the applicant should at the same time bring the description into conformity with the amended claims. This may be complied with using a simple statement which makes clear that the scope of the invention is defined by the appended claims. Care should be taken during revision, not to add subject-matter which extends beyond the content of the application as originally filed (Article 123(2) EPC). According to the case law of the Boards of Appeal (e.g. T284/94), this criterion has to be applied in a strict manner.
12. In order to facilitate the examination of the conformity of the amended application with the requirements of Article 123(2) EPC, the applicant is kindly requested to **clearly identify every amendment carried out, irrespective of whether it concerns addition, replacement or deletion of features**, indicating the passages of the application as filed on which the amendment is based. (Guidelines E-II,1)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Eugene J. ROLLINS *et al.* CONFIRMATION No.: 9835
SERIAL NUMBER : 09/747,651 EXAMINER: Yogesh C. Garg
FILING DATE : December 22, 2000 ART UNIT: 3625
FOR : PRE-FILLING ORDER FORMS FOR TRANSACTIONS OVER A COMMUNICATIONS NETWORK

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the duty of disclosure under 37 C.F.R. §§ 1.56, 1.97 and 1.98, Applicants hereby make of record in the above-identified application the documents listed on the attached Form PTO-1449.

Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This Supplemental Information Disclosure Statement is being filed more than three months after the filing date of a national application other than a continued prosecution application under 37 C.F.R. §1.53(d), or more than three months after the date of entry of the national stage as set forth in 37 C.F.R. §1.491 in an international application, and after the mailing date of any of a Final Action under 37 C.F.R. §1.113, a Notice of Allowance under 37 C.F.R. §1.311, or an action that otherwise closes prosecution in the application, but on or before payment of the Issue Fee. 37 C.F.R. §1.97(d).

These documents were cited by the U.S. Patent Office in co-pending Application Serial No. 09/747,666, filed December 22, 2000, in a Notice of Allowability dated October 15, 2007. I hereby certify that no item of information contained in this Supplemental Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in this Supplemental Information Disclosure Statement was known to any individual designated in 37 C.F.R. §1.56(c) more than three months prior to the filing of this Supplemental Information Disclosure Statement. 37 C.F.R. §1.97(e)(2).

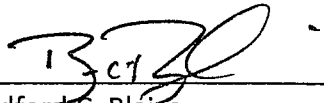
The \$180.00 fee is being paid in connection with the other Supplemental Information Disclosure Statement being filed under even date herewith.

It is respectfully requested that the Examiner initial and return a copy of the enclosed
PTO-1449.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP

Customer No.
00909

By 
Bradford C. Blaise
Registration No.: 47,429

P. O. Box 10500
McLean, Virginia 22102
Telephone: (703) 770-7900
Telefax: (703) 770-7901

Dated: December 14, 2007

[illegible][illegible]

| | | |
|--|---|--|
| | B | BUSH, Vannevar, "As We May Think", <u>The Atlantic Online</u> , July 1945, Volume 176, No. 1, pages 101-108 (14 pages). |
| | C | DOHERTY, Paul, <i>et al.</i> , "Web-Related Applications Power Productivity and Partnering", <u>Building Design & Construction</u> , October 1996, Volume 37, Issue 10, pages 63-68 (5 pages). |

400688595v1